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|  |   |                   |
|--|---|-------------------|
| In re Application of                   | : | DECISION ON       |
| YOH-ICHI MATSUMOTO et al               | : |                   |
| PCT No.: PCT/US99/11179                | : |                   |
| Application No.: 09/700,851            | : | PAPERS FILED      |
| Int. Filing Date: 19 May 1999          | : |                   |
| Priority Date: 20 May 1998             | : |                   |
| Attorney's Docket No.: 019026-000110US | : | UNDER 37 CFR 1.42 |
| For: HUMANIZED ANTIBODIES THAT ...     | : |                   |
| LINE PRODUCING SAME                    | : |                   |

This is a decision on the declaration filed 18 December 2001, which has been treated as a request for status under 37 CFR 1.42.

**BACKGROUND**

On 17 November 2000, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). Applicant, however, did not satisfy the requirement set forth by 35 U.S.C. 371(c)(4) because an executed oath or declaration was not provided at such time.

On 14 December 2000, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a) and(b), identifying the application by International application number and international filing date" must be submitted within one month from its 14 December 2000 date of mailing or by 31 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application. In addition, a surcharge for providing the oath or declaration later than the appropriate 30 months from the priority date will be required under 37 CFR 1.492(e).

On 06 June 2001, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a) and(b), identifying the application by International application number and international filing date" must be submitted within two months from its 06 June 2001 date of mailing or by 32 months from the priority date, whichever is later, in order to avoid

abandonment of the national stage application. In addition, a surcharge for providing the oath or declaration later than the appropriate 30 months from the priority date will be required under 37 CFR 1.492(e).

To satisfy the requirements of 35 U.S.C. 371(c)(4) that an oath or declaration of the inventor be submitted, applicant submitted on 18 December 2001 a declaration signed only by Yoshifumi Takeda (legal representative of Tae Takeda (fourth inventor, now deceased)).

### DISCUSSION

The aforementioned international application may not commence entry to the national stage phase because the declaration does not comply with 37 C.F.R. §1.497(b)(2).

Because the inventor Tae Takeda is deceased and Yoshifumi Takeda has been appointed as the legal representatives for the deceased inventor, 37 C.F.R. §1.497(b)(2) indicates that "[i]f the person making the oath or the declaration or any supplemental or oath or declaration is not the inventor (§§1.42, 1.43, or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state (the inventors citizenship and so on). If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative." (see MPEP § 409.01)

Moreover, none of the other five inventors have signed the declaration to satisfy the requirements 35 USC 371.

### CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **not accepted**.

Applicant is required to provide an oath or declaration in compliance with 37 CFR 1.497(a)-(b) within TWO (2) MONTHS from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42." Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Office of PCT Legal Administration, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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